

## **REMARKS:**

Claims 1-38 are currently pending in the application. Claims 1-6, 9-18, 21-29, 32-36, and 38 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,397,212 to Peter Biffar ("Biffar"). Claims 7, 19, 30, and 37 stand rejected under 35 U.S.C. § 103(a) over Biffar in view of U.S. Patent No. 6,728,685 to Gurpreet Ahluwalia ("Ahluwalia"). Claims 8, 20, and 31 stand rejected under 35 U.S.C. § 103(a) over Biffar.

## **REJECTION UNDER 35 U.S.C. § 102(e):**

Claims 1-6, 9-18, 21-29, 32-36, and 38 stand rejected under 35 U.S.C. § 102(e) over Biffar.

The Office Action alleges that Biffar discloses a system, method, software and means for automatically generating graphical user interface elements at a client system according to a current configuration model. The Applicants have reviewed Biffar in detail, particularly looking for a system, method, software, or means for automatically generating graphical user interface elements at a client system according to a current configuration model, relied upon by the Examiner. However, Biffar fails to disclose each and every limitation recited by claims 1-38. Thus, the Applicants respectfully submit that claims 1-6, 9-18, 21-29, 32-36, and 38 patentably distinguish over Biffar.

For example, with respect to independent claim 1, this claim recites:

A system for automatically generating a graphical user interface (GUI) element at a client system according to a current configuration model, comprising:

a first frame associated with a web page and generated at a server system for communication to a client system in connection with a configuration workflow, when generated the first frame comprising data reflecting the current configuration model, when generated the first frame further comprising a function operable when executed at the client system in response to a call to automatically:

receive a configuration choice selection at a first GUI element;

access the data stored in the first frame reflecting the current configuration model;

according to the accessed data, determine one or more configuration choices for which a second GUI element needs to be drawn for display to a user associated with the client system in connection with the configuration workflow in response to the configuration choice selection of the first GUI element; and

make a callback requesting that the second GUI element for the one or more configuration choices be drawn; and

a second frame associated with the web page and generated at the server system for communication to the client system in association with the first frame, when generated the second frame comprising one or more parameters specifying the second GUI element that will be appropriate for the one or more configuration choices depending on the current configuration model as reflected in the data stored in the first frame in response to the configuration choice selection, when generated the second frame further comprising code operable when executed at the client system to automatically:

call the function of the first frame to determine the one or more configuration choices for which the second GUI element needs to be displayed to the user associated with the client system in connection with the configuration workflow;

receive a callback from the function of the first frame requesting that the second GUI element for the one or more configuration choices be drawn; and

according to the one or more parameters stored in the second frame, draw the second GUI element that is appropriate for the one or more configuration choices. (Emphasis Added).

Independent claims 13, 24, 36, 37, and 38 recite similar limitations. Biffar fails to disclose each and every limitation of independent claims 1, 13, 24, 36, 37, and 38.

For example, the Examiner asserts that the search engine in Biffar corresponds to the web-based communication, as might occur over the Internet in connection with electronic commerce environments, such as those associated with electronic marketplaces or other Internet websites at which products may be configured for purchase. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Biffar.

The Applicants respectfully submit that Biffar does not disclose the automatic generation of a graphical user interface element at a client system according to a current

configuration model. Although Biffar discloses a search engine for providing searches, (Abstract), Biffar does not disclose, teach, or suggest the search engine automatically generates the graphical user interface element at a client system according to a current configuration model or automatically changing the configuration model in the graphical user interface elements displayed to a user during a configuration workflow. In fact, Biffar teaches away from the claimed invention since Biffar teaches a search engine that will increase costs associated with maintaining a website (Column 1, Lines 37 et seq.), delay implementation of changes to the configuration graphical user interface (Column 11, Lines 15-25), and a subsequent decrease in user satisfaction due to display of inappropriate graphical user interface elements (Column 9, Lines 38 et seq.). Furthermore, Biffar does not disclose, teach, or suggest that the search results received from the search engine update a configuration model, a configuration workflow or any other type of configuration or database on, at, or in a client system. Thus, Biffar cannot automatically generate a graphical user interface element at a client system according to a current configuration model since Biffar does not even decrease costs associated with maintaining a website, speed implementation of configuration graphical user interface changes, or increase user satisfaction through the display of more appropriate graphical user interface elements.

The Applicants further submit that Biffar does not disclose a first frame associated with a web page and generated at a server system for communication to a client system in connection with a configuration workflow to determine configuration choices for which a second graphical user interface element needs to be drawn for display to a user associated with the client system in connection with the configuration workflow in response to the configuration choice selection of the first graphical user interface element, as cited by the Examiner. (9 June 2005 Office Action, Page 3). The Applicants direct the Examiner's attention to the cited text of Biffar which states:

Bundling of Product/Services: If a person searched for a car, the system also facilitates the search for related products and services, such as financing and insurance. The system uses the information available about the user and the car selected to offer or suggest financing. (Column 9, Lines 38-42) (Emphasis Added).

The Applicants respectfully submit that the Examiner has misdescribed the search engine disclosed in Biffar. The above-cited text of Biffar merely describes an approach of Biffar's search engine to bundle products or services into the actual search conducted by a user. Biffar does not disclose, teach or suggest a first frame associated with a web page and generated at a server system for communication to a client system in connection with a configuration workflow to determine configuration choices for which a second graphical user interface element needs to be drawn for display to a user associated with the client system in connection with the configuration workflow in response to the configuration choice selection of the first graphical user interface element. As mentioned above, Biffar teaches away from the claimed invention since the bundling of products or services of Biffar's search engine actually delay's the implementation or changes to the configuration of graphical user interface and inherently decreases the user satisfaction due to the display of unsolicited bundling of additional products or services to the graphical user interface elements. In fact, Biffar may be seen as spamming the user with unsolicited products or services as a result of the user using Biffar's search engine. Thus, Biffar cannot provide a system, method, software or means for automatically generating graphical user interface elements at a client system according to a current configuration model.

Thus, the allegation in the present Office Action that Biffar discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Biffar is considered to anticipate all of the limitations in independent claim 1. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. The Applicants respectfully points out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that the Office Action has failed to establish a prima facie case of anticipation in independent claim 1 under 35 U.S.C. § 102 with respect to Biffar because Biffar fails to identically disclose every element of the Applicants claimed invention, arranged as they are in Applicants claim.

With respect to independent claims 13, 24, 36, 37, and 38 each of these claims includes limitations similar to those discussed above in connection with independent claim 1. Thus, independent claims 13, 24, 36, 37, and 38 are considered patentably distinguishable over Biffar for at least the reasons discussed above in connection with independent claim 1. Furthermore, dependent claims 2-6 and 9-12 which depend from independent claim 1, dependent claims 14-18 and 21-23 which depend from independent claim 13, and dependent claims 25-29 and 32-35 which depend from independent claim 24 are also considered patentably distinguishable over Biffar. Thus, dependent claims 2-6, 9-12, 14-18, 21-23, 25-29, and 32-35 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for the reasons set forth herein, the Applicants submit that claims 1-6, 9-18, 21-29, 32-36, and 38 are not anticipated by Biffar. The Applicants further submit that claims 1-6, 9-18, 21-29, 32-36, and 38 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1-6, 9-18, 21-29, 32-36, and 38 under 35 U.S.C. § 102(e) be reconsidered and that claims 1-6, 9-18, 21-29, 32-36, and 38 be allowed.

#### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things

co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.



When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 7, 19, 30, and 37 stand rejected under 35 U.S.C. § 103(a) over Biffar in view of Ahluwalia. Claims 8, 20, and 31 stand rejected under 35 U.S.C. § 103(a) over Biffar.

The Applicants respectfully submit that Biffar or Ahluwalia either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 7, 8, 19, 20, 30, 31, and 37. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of claims 7, 8, 19, 20, 30, 31, and 37 under 35 U.S.C. § 103(a) over the proposed combination of Biffar and Ahluwalia either individually or in combination.

For example, with respect to dependent claim 7, this claim recites:

The system of Claim 1, wherein:  
the first and second frames comprise JavaServer Pages (JSPs),  
the called function of the first frame comprises a JavaScript function, and  
the calling code of the second frame comprises JavaScript code.  
(Emphasis Added).

Dependent claims 19 and 30 recite similar limitations. Biffar or Ahluwalia either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 7, 19 or 30.

The Applicants respectfully submit that the Office Action acknowledges, and Applicants agree, that Biffar fails to disclose the emphasized limitations noted above in dependent claims 7, 19, or 30. Specifically the Examiner acknowledges that Biffar fails to disclose the first and second frames comprising JavaServer Pages, the called function of the first frame comprises a Javascript function, and the calling code of the second frame comprises Javascript code as recited in the claims. (2 June 2005 Office Action, Page 8). However, the Examiner asserts that the cited portions of Ahluwalia disclose the acknowledged shortcomings in Biffar. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Ahluwalia.

The Applicants respectfully submit that Ahluwalia has nothing to do with dependent claim 7 limitations regarding: (1) the first and second frames comprising JavaServer Pages; (2) the called function of the first frame comprising a Javascript function; and (3) the calling code of the second frame comprising Javascript code. Rather Ahluwalia discloses an online communication system for accessing files called web pages that may be documents created using hypertext markup language (HTML) or Java applets and serverlets. (Column 7, Lines 42-50). Ahluwalia merely discloses a system for accessing files and does not teach, suggest, or even hint at: (1) the first and second frames comprising JavaServer Pages; (2) the called function of the first frame comprising a Javascript function; and (3) the calling code of the second frame comprising Javascript code. Thus, Ahluwalia cannot provide a system, method, software, or means for automatically generating graphical user interface elements at a client system according to a current configuration model, since Ahluwalia does not even provide a first frame, a second frame, a called function of the first frame, a calling code of the second frame, a javascript function, or a Javascript code, as recited in the claims.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Biffar

or Ahluwalia, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Biffar to include the JavaScript of Ahluwalia, "in order to obtain JavaScript capabilities for creating the connections" (9 June 2005 Office Action, Page 8).

The Applicants further submit that this purported advantage relied on by the Examiner to make such a combination "in order to obtain JavaScript capabilities for creating the connections" is nowhere disclosed, taught, or suggested in Biffar or Ahluwalia either individually or in combination. The Applicants respectfully direct the Examiner's attention to independent claim 1, this claim recites:

A system for automatically generating a graphical user interface (GUI) element at a client system according to a current configuration model, comprising:

- a first frame associated with a web page and generated at a server system for communication to a client system in connection with a configuration workflow, when generated the first frame comprising data reflecting the current configuration model, when generated the first frame further comprising a function operable when executed at the client system in response to a call to automatically:

- receive a configuration choice selection at a first GUI element;

- access the data stored in the first frame reflecting the current configuration model;

- according to the accessed data, determine one or more configuration choices for which a second GUI element needs to be drawn for display to a user associated with the client system in connection with the configuration workflow in response to the configuration choice selection of the first GUI element; and

- make a callback requesting that the second GUI element for the one or more configuration choices be drawn; and

- a second frame associated with the web page and generated at the server system for communication to the client system in association with the first frame, when generated the second frame comprising one or more parameters specifying the second GUI element that will be appropriate for the one or more configuration choices depending on the current configuration model as reflected in the data stored in the first frame in response to the configuration choice selection, when generated the

second frame further comprising code operable when executed at the client system to automatically:

- call the function of the first frame to determine the one or more configuration choices for which the second GUI element needs to be displayed to the user associated with the client system in connection with the configuration workflow;

- receive a callback from the function of the first frame requesting that the second GUI element for the one or more configuration choices be drawn; and

- according to the one or more parameters stored in the second frame, draw the second GUI element that is appropriate for the one or more configuration choices.

Dependent claim 7 depends from independent claim 1.

The Applicants respectfully disagree with the Examiner and do not understand what is meant by “in order to obtain JavaScript capabilities for creating the connections” (9 June 2005 Office Action, Page 8), in relation to the limitations discussed above in connection with independent claim 1 or dependent claim 7. The Applicants respectfully request the Examiner to clarify what is meant by “in order to obtain JavaScript capabilities for creating the connections”. Thus, the Examiner’s allegation in the present Office Action to make such a combination is respectfully traversed.

The Applicants respectfully request the Examiner to point to the portions of Biffar or Ahluwalia which contain the teaching, suggestion, or motivation to combine these references. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Biffar or Ahluwalia either individually or in combination.

The Applicants respectfully submit that the Office Action further acknowledges, and Applicants agree, that Biffar fails to disclose the emphasized limitations in dependent claims 8, 20, and 31. Specifically the Examiner acknowledges that Biffar fails to teach the

first frame to be non-viewable as recited in the claims. (9 June 2005 Office Action, Page 9). However, the Examiner asserts that within the filed of the invention, it would be obvious to one of ordinary skill in the art to make the first frame non-viewable. The Applicants respectfully traverse the Examiner's assertions.

As mentioned above, Biffar fails to disclose, teach, or suggest a first frame to be non-viewable as recited in dependent claims 8, 20, and 31. Thus, the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Biffar or the knowledge generally available to those of ordinary skill in the art at the time of the invention, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in Biffar or in knowledge generally available to those of ordinary skill in the art at the time of the invention, to combine as proposed with Biffar. The Office Action merely states that it would have been obvious to one of ordinary skill in the art to make the first frame non-viewable.

The Applicants respectfully submit that this purported advantage relied on by the Examiner to make such a combination, is nowhere disclosed, taught, or suggested in Biffar or in knowledge generally available to those of ordinary skill in the art at the time of the invention, either individually or in combination. The Applicants respectfully request the Examiner to point to the portions of Biffar or to knowledge generally available to those of ordinary skill in the art at the time of the invention which contains the teaching, suggestion, or motivation to combine these references for the purpose of obtaining a way to view information without allowing the user to edit it. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Biffar or in knowledge generally available to those of ordinary skill in the art at the time of the invention, either individually or in combination.

With respect to dependent claims 7, 8, 19, 20, 30, and 31, claims 7 and 8 depend from independent claim 1, claims 19 and 20 depend from independent claim 13, and claims 30 and 31 depend from independent claim 24. As mentioned above, each of independent claims 13 and 24 includes limitations similar to those discussed above in connection with independent claim 1. Thus, independent claims 13 and 24 are considered patentably distinguishable over Biffar for at least the reasons discussed above in connection with independent claim 1. Thus, dependent claims 7, 8, 19, 20, 30, and 31 are considered patentably distinguishable over the proposed combination of Biffar and Ahluwalia for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

Independent claim 37 includes limitations similar to those discussed above in connection with independent claim 1. Thus, independent claim 37 is considered patentably distinguishable over Biffar for at least the reasons discussed above in connection with independent claim 1. Furthermore, independent claim 37 includes limitations similar to those discussed above in connection with dependent claims 7, 8, 19, 20, 30, and 31. Thus, independent claim 37 is considered patentably distinguishable over the proposed combination of Biffar and Ahluwalia for at least the reasons to those discussed above in connection with dependent claims 7, 8, 19, 20, 30, and 31 and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicants submit that claims 7, 8, 19, 20, 30, 31, and 37 are not rendered obvious by the proposed combination of Biffar, Ahluwalia, or in knowledge generally available to those of ordinary skill in the art at the time of the invention. The Applicants further submit that claims 7, 8, 19, 20, 30, 31, and 37 are not rendered obvious by the proposed combination of Biffar, Astola, or in knowledge generally available to those of ordinary skill in the art at the time of the invention, and are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 7, 8, 19, 20, 30, 31, and 37 under 35 U.S.C. § 103(a) be reconsidered and that claims 7, 8, 19, 20, 30, 31, and 37 be allowed.

## **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.



**CONCLUSION:**

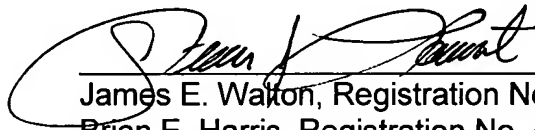
In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

7/19/05  
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